



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,767	04/07/2005	Rajinder Singh	02-438-B1	9966
<div>20306      7590      10/25/2007</div> <div>MCDONNELL BOEHNEN HULBERT &amp; BERGHOFF LLP</div> <div>300 S. WACKER DRIVE</div> <div>32ND FLOOR</div> <div>CHICAGO, IL 60606</div>				
			<div>EXAMINER</div> <div>CHU, YONG LIANG</div>	
			<div>ART UNIT</div> <div>1626</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>10/25/2007</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/530,767	Applicant(s) SINGH ET AL.	
	Examiner Yong Chu	Art Unit 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25, 28-34 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) 30-34 and 38-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 28, 29, and 42-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/20/2007</u> . | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 09/20/2007 has been entered. Claims 25, 28-34, and 38-46 are pending. Claims 30-34, and 38-41 are Non-elected subject matter. Claims 25, 28, 29, and 42-46 are examined on the merits.

### ***Information Disclosure Statement***

Applicant's Information Disclosure Statement, filed on 09/20/2007, has been considered. Please refer to Applicant's copies of the PTO-1449 submitted herewith.

### ***Respond to Arguments***

#### **Restriction**

The Office extends the scope of searching on R<sup>44</sup> to include aryl. New prior arts have been identified necessitated by the new IDS filed with RCE dated 09/20/2007.

### ***Claim Rejections - 35 USC § 102(b)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

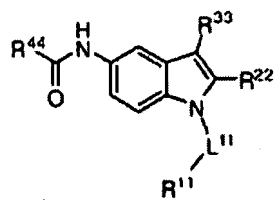
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1626

Claims 25, 42, and 43 are rejected under 35 U.S.C. 102 (b) as being anticipated by Sainsbury *et al.*, Journal of the Chemical Society, Perkin Transactions 1: Organic and Bio-Organic Chemistry, (1974), (13), 1580-4, ("Sainsbury *et al.*").

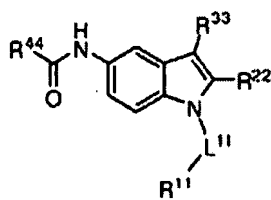
Applicants' claims relate to a composition comprising compounds of Formula (I)



, wherein:

$L^{11}$  is a bond;  $R^{11}$  is H;  $R^{22}$  and  $R^{33}$  are as defined in claim 25;

$R^{44}$  is an optionally substituted  $C_{3-6}$  monocyclic heteroaryl, an optionally substituted  $C_{3-6}$  monocyclic heterocyclic, optionally substituted  $C_{3-7}$  monocyclic or  $C_{7-13}$  biocyclic aryl; and  $R^{50}$ ,  $R^6$ ,  $R^7$ , and  $R^{23}$  are each independently as defined in claim 25.



, wherein:

$L^{11}$  is a bond;

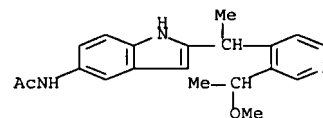
$R^{11}$  is H;

$R^{22}$  and  $R^{33}$  are as defined in claim 25; and

$R^{44}$  is an optionally substituted  $C_{3-6}$  monocyclic heteroaryl containing at least one N, O or S atom; or an optionally substituted  $C_{3-6}$  monocyclic heterocycle containing at least one N, O or S atom;

$R^{50}$ ,  $R^6$ ,  $R^7$  and  $R^{23}$  are each independently as defined in claim 25.

Art Unit: 1626

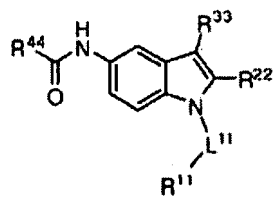


Sainsbury *et al* disclose a compound (54368-90-0)

This compound anticipated the instant claims, wherein  $L_{11}$  is a bond;  $R_{11}$  is H;  $R_{33}$  is H;  $R_{44}$  is an optionally substituted  $C_{1-6}$ alkyl;  $R_{22}$  is a substituted ethyl group. According to claim 25,  $R^{22}$  is defined as a  $C_{1-6}$ alkyl. There is no definition in the specification on the term " $C_{1-6}$ alkyl". The Office gives the term the broadest possible interpretation in light of specification, namely substituted or unsubstituted  $C_{1-6}$ alkyl. The Office presumes the compound is in solution as a composition. A pharmaceutical carrier could be water.

Claims 25, 28, 29, and 42-46 are rejected under 35 U.S.C. 102 (b) as being anticipated by the compounds disclosed in Peakdale Catalog, see IDS cite No. 2 page 6 of 8, filed by Applicant on 09/20/2007.

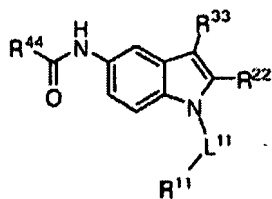
Applicants' claims relate to a composition comprising compounds of Formula (I)



, wherein:

$L^{11}$  is a bond;  $R^{11}$  is H;  $R^{22}$  and  $R^{33}$  are as defined in claim 25;

$R^{44}$  is an optionally substituted  $C_{3-6}$  monocyclic heteroaryl, an optionally substituted  $C_{3-6}$  monocyclic heterocyclic, optionally substituted  $C_{3-7}$  monocyclic or  $C_{7-13}$  biocyclic aryl; and  $R^{50}$ ,  $R^6$ ,  $R^7$ , and  $R^{23}$  are each independently as defined in claim 25.



, wherein:

$L^{11}$  is a bond;

$R^{11}$  is H;

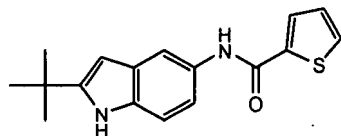
$R^{22}$  and  $R^{33}$  are as defined in claim 25; and

$R^{44}$  is an optionally substituted  $C_{3-6}$  monocyclic heteroaryl containing at least one N, O or S atom; or an optionally substituted  $C_{3-6}$  monocyclic heterocycle containing at least one N, O or S atom;

$R^{50}$ ,  $R^6$ ,  $R^7$  and  $R^{23}$  are each independently as defined in claim 25.

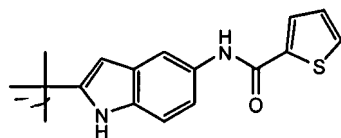
More

specifically, Claim 46 disclosed a composition comprising the compound



N-(2-t-butyl-1H-indol-5-yl)-thiophene-2-carboxamide

The Peakdale Catalog disclosed the same compound



N-(2-t-butyl-1H-indol-5-yl)-thiophene-2-carboxamide as compound No 281, catalog # PFC-1019. The

Office presumes the compound is in solution as a composition. A pharmaceutical carrier could be water. Therefore, the prior art anticipates the instant Claims 25, 28, 29, and 42-46.

### Conclusion

No claims are allowed.

Art Unit: 1626

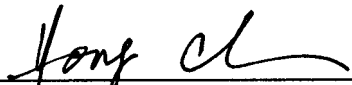
***Telephone Inquiry***

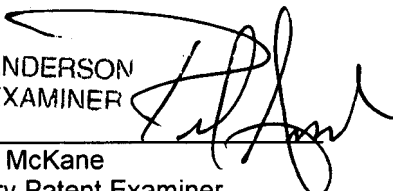

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yong Chu, Ph.D.  
Patent Examiner  
Art Unit 1626

REBECCA ANDERSON  
PRIMARY EXAMINER   
 Joseph M. McKane  
Supervisory Patent Examiner  
Art Unit 1626